

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of:)	
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Thomas C. Kienzle III)	
)	
Serial No.: 10/535,092)	Electronically filed
)	on October 14, 2009
Filed: 05/13/2005)	
)	
For: INTERCHANGEABLE LOCALIZING)	
DEVICES FOR USE WITH TRACKING)	
SYSTEMS)	
)	
Examiner: Salieu M. Abraham)	
)	
Group Art Unit: 3768)	
)	
Confirmation No.: 1923)	

ELECTION WITH TRAVERSE

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Examiner Abraham:

This Paper responds to the Office Action mailed September 29, 2009. The Office Action states that restriction to one of the following is required under 35 U.S.C. 121:

- I. Claims 1-8 and 41, drawn to a system and method for tracking the position of an instrument relative to (an) area(s) of interest, classified in class 606, subclass 130.
- II. Claims 9, 18-19, and 33-38, drawn to a system and method for localizing instruments relative to a patient's bone, classified in class 128, subclass 899.
- III. Claims 10-17 and 20, drawn to system and method for electromagnetically tracking the position of a surgical instrument relative to an image of a patient's body, classified in class 600, subclass 427.

IV. Claims 21-32 and 39-40, drawn to a system and method for extending the operating range of a tracking system using localizing devices, in class 702, subclass 155.

See September 29, 2009 Office Action at page 2.

The Applicants elect, **with traverse**, the inventions of Group I, namely claims 1-8 and 41.

TRAVERSAL

The Applicants traverse this restriction requirement because “[i]f the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.” See Manual of Patent Examining Procedure (MPEP) at § 803. The Applicants respectfully submit that the Office Action has not established a *prima facie* serious burden with respect to a **search and examination** of all the claims.

One of the “two criteria for a proper requirement for restriction between patentably distinct inventions” is that “[t]here would be a serious burden on the examiner if restriction is not required” MPEP § 803 (emphasis added). While “[f]or purposes of the initial requirement a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search . . . [t]hat *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant.” MPEP § 803 (emphasis added). The Applicants rebut the Examiner’s *prima facie* showing in this case because the Examiner previously performed a search and examination for all of the claims as evidenced by the fact that the Examiner issued an office action on the merits for all 41 claims of the pending application on November 23, 2007. In order to have prepared such an Action, the

Examiner presumably must have already conducted a thorough search and examination for all of the claims. Therefore, there does not appear to be a serious search and examination burden if restriction were not required.

For at least the reasons discussed above, the Applicants respectfully request reconsideration of the restriction requirement. Indeed, all of the pending claims of the present application should be examined together due to the fact that the Office Action has not established a *prima facie* showing of a serious burden with respect to the search and examination of these claims.

The Applicants are aware that if this restriction requirement is made final, it will be necessary to file a Petition if this traversal is to be pursued.

If the Examiner has any questions or the Applicants can be of any assistance, the Examiner is invited to contact the undersigned attorney. While no fee is believed due with respect to this Election, the Commissioner is nevertheless authorized to charge any necessary fees, or credit any overpayment to the Deposit Account 070845.

Respectfully submitted,

Date: October 14, 2009

/David Z. Petty/

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